



AFS
JFW

PATENT
Customer No. 22,852
Attorney Docket No. 5725.0848-00
Application No.: 09/931,913

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Nghi Van Nguyen et al.) Group Art Unit: 1751
)
Application No.: 09/931,913) Examiner: E. Elhilo
)
Filed: August 20, 2001)
)
For: COMPOSITIONS COMPRISING) Confirmation No.: 4345
AT LEAST ONE HYDROXIDE)
COMPOUND AND AT LEAST ONE)
OXIDIZING AGENT, AND)
METHODS TO STRAIGHTEN)
CURLY HAIR)

Mail Stop Appeal Brief-Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellants present this Reply to the Examiner's Answer dated January 23, 2007. A Request for Oral Hearing is concurrently filed with this Reply Brief.

If any fees are required in connection with the filing of this paper that are not filed herewith, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

I. Related Appeals and Interferences

Appellants are aware of related case 09/838,197 (Attorney Docket No. 05725.0505) in which an Appeal was filed to the Board on January 11, 2007.

II. Argument

In the Answer, the Examiner continues to ground the two rejections on conclusions that have no basis in fact or law. While paying lip-service to the elements for establishing a prima case of obviousness, he concludes that each criteria for establishing such a case has been met because “all references are in the same analogs [sic] of keratin fibers treating formulation.” *Examiner’s Answer*, page 6. Appellants disagree with this unfounded conclusion.

To establish obviousness, the Examiner must prove that three requirements are met—(1) a suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference; (2) a reasonable expectation of success in so modifying; and (3) a teaching or suggestion of each claimed limitation in that reference. *In re Merck & Co., Inc.*, 800 F.2d 1091, 213 USPQ 375 (Fed. Cir. 1986). In proving these requirements, the initial burden rests on the Examiner to provide a “convincing line of reasoning” as to why a reference suggests doing what the Appellants have ultimately done. *Ex Parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Here, the Examiner presents no line of reasoning let alone a convincing one.

Indeed, the Examiner continues to improperly assert that *Au*’s broad teachings evidence the obviousness of the claimed invention. Specifically, he grounds his conclusion of obviousness on *Au*’s alleged teaching of the “equivalence” of detergent and personal care compositions. In addition, the Examiner also improperly contends

that the combination of *Au* and *Pyles* render claim 29 obvious simply because both mention hair compositions. As discussed in detail below, these broad, conclusory assertions simply do not amount to an establishment of a prima facie case of obviousness. Accordingly, the Examiner has not met his burden.

A. Rejection of Claims 1-20, 22-28, and 30-45 Over *Au*

1. The Examiner's Rejection is Based on a Flawed Belief of "Equivalency"

The Examiner has improperly attempted to rebut the arguments made in Appellants' Appeal Brief by relying on the "equivalency" doctrine. *Examiner's Answer*, pages 6-8. Appellants have maintained that *Au* fails to render the claimed invention obvious because it does not teach or suggest selecting sodium hydroxide and complexing agents from shampoo compositions, oxidizing agents from detergent compositions, and combining these components in an effective amount to lanthionize keratin fibers. In response to this argument, the Examiner has asserted that *Au* "teaches and discloses detergent and personal product compositions as . . . equivalence [sic] compositions that have common properties." *Examiner's Answer*, page 6. Likewise, in response to Appellants' argument that *Au* does not teach or disclose "a composition for lathionizing keratin fibers wherein the at least one hydroxide compound and the at least one oxidizing agent are present in the composition in a sufficient quantity to effect lathionization of keratinous fibers," as presently claimed, the Examiner again responded "*Au* teaches equivalence compositions (detergents and shampoos) that have common properties." *Examiner's Answer*, page 8. This "equivalency" argument, however, is unsupported by the facts and moreover, does not logically flow from the teachings of the *Au* reference.

In order for the Examiner to rely on equivalency, the prior art must recognize that equivalency. *Au*, however, neither explicitly nor implicitly discloses that shampoos and detergents are equivalent. The Examiner cites to col. 3, lines 23-36 as support for his “equivalency” argument, but a review of this section does not justify his conclusion. In fact, all this section reveals is that *Au*’s invention (i.e. a novel surfactant) can be used in detergent and personal product compositions and can improve the properties of these compositions. For example, *Au* discloses the following:

Accordingly, it is the object of the present invention to provide new and improved detergent and personal product compositions that have excellent cleansing properties.

Col. 3, lines 23-25. Nothing in this paragraph (or any other paragraph on which the Examiner relies), suggests that detergent and shampoos are equivalent. In fact, shampoos are never even mentioned.

Because *Au* never explicitly states that shampoos and detergents are equivalent, it can only be concluded that the Examiner makes this assertion merely because the words “detergent” and “personal care product compositions” appear in the same sentence. This, however, hardly evidences proof of equivalence. Indeed, equivalency requires recognition in the prior art not conclusory opinions based on conjecture and speculation. See *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958). In *Ruff*, the Court rejected the notion that equivalency can be established based on the mere fact that components are listed in a Markush group. Similarly, the Examiner cannot establish equivalency here based on the mere fact that the words detergent and personal care products appear in the same sentence.

Equivalency also cannot be established based on the Examiner’s assertion that *Au* discloses that detergent and personal care products have common properties. See,

e.g. *Examiner's Answer*, page 6. *Au* never discloses that alleged fact. What *Au* does disclose is the use of glycosylamide surfactants in detergent and personal care product compositions. *Abstract*. The glycosylamide surfactant is the reason these specific compositions have some similar properties not the fact that these compositions are the same.

2. The Examiner Continues to Misinterpret *Au*'s Teachings of Hydrogen Peroxide

Similar to the "equivalency" argument, the Examiner also makes improper assertions about *Au*'s teachings of hydrogen peroxide. Despite Appellants's repeated arguments to the contrary, the Examiner continues to argue that *Au* teaches a "composition compris[ing] bleaching agents (oxidizing agents) such as hydrogen peroxide in the amounts 0.01 to 7% (see col. 30, lines 5-16)." *Examiner's Answer*, page 7. As Appellants have previously argued, *Au* does not disclose a composition containing from 0.01 to 7% bleaching agents (e.g. hydrogen peroxide). What *Au* does in fact disclose is the use of bleaching agents, such as hydrogen peroxide, to make the glycosylamide surfactant. The section that the Examiner continues to rely on does not refer to a composition containing a bleaching agent. To the contrary, this section discusses an optional bleaching process step (which includes a bleaching agent) that can occur after the reaction process to make the glycosylamide surfactant. Thus, *Au* does not disclose a "composition compris[ing] bleaching agents (oxidizing agents) such as hydrogen peroxide in the amounts 0.01 to 7% (see col. 30, lines 5-16)."

Likewise, the Examiner also mistakenly argues that *Au* discloses a heat-activated composition. More specifically, the Examiner relies on the manufacturing process section in *Au* as evidence of a motivation to make the claimed composition recited in

Claim 42. Claim 42 recites that the claimed composition should be heat-activated.

Although *Au* never discloses, or much less hints at, the possibility of a heat activated composition, the Examiner contends that *Au* “teaches a composition that comprises all of the claimed ingredients wherein the formation of the composition required heating” *Examiner’s Answer*, pages 4-5. This is incorrect. The section for which the Examiner relies to support this argument, *Au*, col. 24, lines 56-61, refers to the reaction process to make the glycosylamide surfactant and not to a composition, as the Examiner contends. In fact, this section specifically refers to a reaction- “[t]he reaction can be performed at or below room temperature, however, shorter reaction times can be achieved at an elevated temperature.” *Au*, col. 24, lines 56-58. Thus, the Examiner has again simply misread and misapplied the *Au* reference.

The Examiner’s argument with respect to claim 42 provides further evidence of his strategy, that is, patching together unrelated sections in *Au* in an effort to reject the claims. This slapdash rejection, however, is grounded in nothing more than hindsight and thus the rejection is improper and should be reversed and withdrawn.

3. Appellants Are Not Required to Show Criticality if Prima Facie Case Not Proven

Finally, the Examiner attempts to improperly shift the burden of establishing obviousness by contending that Appellants need to show “criticality of the combination” on the record. *Examiner’s Answer*, pages 8-9. This simply is not the law. The burden rests firmly with the examiner until he provides factual support for a conclusion of obviousness. *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976). Until that point, the Appellants have no obligation to submit evidence of non-obviousness, either

on the record or otherwise, showing the criticality of the claimed combination.

Accordingly, the Examiner is wrong as a matter of law.

B. Claim 29

With respect to the rejection of claim 29, the Examiner continues to misquote from the teachings of the *Au* reference. The Examiner has repeatedly contended that *Au* suggests the use of amino acids and *Pyles* teaches a glutamate compound, a species of amino acid; thus, there is a motivation to one skilled in the art to incorporate the glutamate compound into *Au*'s composition.

The fundamental flaw in the Examiner's argument is *Au* does not teach or suggest amino acids. Nor does it teach the "use of amino acids as the moisturizing agents in the composition." *Examiner's Answer*, page 9. In fact, *Au* only discloses that preferred moisturizers for use in its invention include "essential amino acid compounds found natural in the skin." Col. 10, lines 62-65. The Examiner has not provided a single reason why one skilled in the art would have sought to modify the *Au* reference to include a non-essential amino acid, such as glutamate. Accordingly, for at least this reason, and the reasons already of record, the rejection should be reversed and withdrawn.

III. Conclusion

For the reasons given above, pending claims 1-20 and 22-45 are allowable and reversal of the Examiner's rejection is respectfully requested.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith,

including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 22, 2007

By: Mareesa A. Frederick
Mareesa A. Frederick
Reg. No. 55,190